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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/620,038
Filing Date: July 15, 2003
Appellant(s): SHIMEK ET AL.

Everett Diederiks
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 29, 2009 appealing from the Office action mailed January 12, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

The rejection of claims 16-18, 21, 23, 25, 26, and 33 under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933) in view of Zietlow (US 6207216 B1) recited in the brief and the previous office action contains a typographical error. As claim 21 includes all the limitations of claim 20, although claim 20 was not recited in the statement of the rejection, claim 20 was necessarily included in the rejection. Thus, the correct grounds reads, claims 16-18, 20, 21, 23, 25, 26, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933) in view of Zietlow (US 6207216 B1).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2004/0109933	ROY et al	6-2004
US 6,309,686 B1	ZIETLOW et al	10-2001
US 6,207,216 B1	ZIETLOW et al	3-2001
US 4,251,561	GAJEWSKI	2-1981

Igoe, Dictionary of Food Ingredients 4th Edition, Aspen Publishers, 2001, pp 66, 67, and 128.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-9, 14, 15, 32, 38, and 81 are rejected under 35 U.S.C. 102(e) as anticipated by Roy et al (US 2004/0109933).

Roy teaches of a dried aerated confection (paragraph 0016) comprising sucrose which is a saccharide component (paragraph 0010), glycerin which is a softening agent (paragraph 0010), gelatin which is a protein based foaming and structuring agent (paragraph 0011), 1-5% moisture (paragraph 0005), flavors and colors (paragraph 0014). Roy teaches that the moisture content of the marshmallow is adjusted based on the final product desired (paragraphs 0004-0006 and 0016). In Example 1, Roy teaches a final product which comprises 0.1% water, 89.22% of a sucrose solution, 5.7% of a gelatin solution, and 0% fat. The sucrose solution consists of 65.72% sucrose, 12.38% corn syrup, 10.29% dextrose, and 11.61% water. The gelatin solution consists of 33.33% gelatin and 66.67% water. Thus the final product as taught by Roy in Example 1 comprises 0.1% water, 89.22% of a sucrose solution with a majority of the saccharide

componet as sucrose (or about 9% dextrose, about 10% corn syrup, about 59% sucrose, and about 10% water), and 5.7% of a gelatin solution (or about 4% water and 2% gelatin). The final product as taught by Roy in Example 1 contains about 14% water (10% from the sucrose solution and 4% from the gelatin solution) and thus about 86% dry ingredients. Thus on a dry weight basis, the final composition of Example 1, as taught by Roy contains about 2% gelatin and about 90% saccharide components or 11% dextrose, about 11% corn syrup, about 68% sucrose. Roy teaches that glycerin alone is substituted for dextrose (paragraph 0010), thus Roy teaches that about 11% glycerin (i.e. a softening agent) on a dry weight basis is included in the marbit composition. Roy teaches that the density of the aerated confection as 0.17-0.48g/cc (Paragraph 0007).

Regarding the glass transition temperature of the aerated confection as recited in claims 1 and 5 and the spring back factor of the aerated confection as recited in claims 1 and 32, as claim 1 recites, "about 5-25% of a softening agent to provide a glass transition temperature... and a spring back factor..." and the claims recite that the softening agent is glycerin (instant claims 8 and 12), since Roy teaches of an aerated confection with substantially the same confectionary composition as instantly claimed, including the instantly claimed softening agent within the instantly claimed range, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same properties provided from the softening agent, including glass transition temperature and spring back factor, as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the aerated confection as "soft", as recited in claim 1, as softness is a function of moisture content and softening ingredients and since Roy teaches of an aerated confection with substantially the same composition as instantly claimed, including the instantly claimed softening agent within the instantly claimed range and the instantly claimed moisture content, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same "softness" as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the water activity of the aerated confection as recited in claim 1, as water activity is a measure of the water available to transfer within a product and thus a function of the water binding properties of the ingredients within a product, particularly water and the humectants (i.e. substances that were known to absorb moisture, such as glycerin) and since Roy teaches of an aerated confection with substantially the same composition as instantly claimed, including the instantly claimed humectants within the instantly claimed range and the instantly claimed moisture content, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same water activity as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the compressibility and bulk compressibility of the aerated confection as recited in claims 7 and 81, as bulk compressibility is based on product composition and the degree of aeration provided to the product and since Roy teaches of an aerated confection with substantially the same composition as instantly claimed and with substantially the same density and thus degree of aeration, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same compressibility and bulk compressibility as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Appellant is reminded that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not." In re Spada, 911F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, it is noted that appellant has chosen to use an equation with parameters that cannot be measured by the Office, for the purpose of prior art comparison, because the office is not equipped to manufacture prior art products and compare them for patentability. Therefore, the burden is shifted to the appellant to show that the prior art product is different.

Claims 10-13, 19, 20, 22, 24, 27, 29-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933) in view of Zietlow (US 6309686 B1).

Roy teaches of a dried aerated confection comprising a softening agent consisting of glycerin and possessing substantially the same water activity as instantly claimed, as discussed above. Roy teaches that marbits are cut into appropriate shapes and sizes (Paragraphs 0014 and 0016). Roy is silent to the size and weights of the confection including about 0.1-10 grams and preferably about 0.1-0.2 grams as recited in claims 10 and 11, and to how the marbits are consumed, including the marbit having a portion of a second color as recited in claims 19 and 24, the marbit as a phase or portion of a composite food product as recited in claim 20, the marbit as in the form of a filling or core in a composite food product as recited in claims 22 and 29, the marbit as in the form of a peripheral border as recited in claim 27, and the marbit as admixed with a dry particulate matter, including a ready-to-eat (RTE) cereal as recited in claims 30, 31, and 36.

Zietlow teaches of aerated confections, including marbits. Zietlow teaches that marbits are consumed as novelty confections or are added to ready to eat breakfast cereals. Zietlow teaches that marbits are cut into pieces weighing about 0.16-0.25 grams. Refer specifically to Abstract and Column 1 lines 20-35. Zietlow teaches an improved aerated confection which is made up of two marbit phases. Zietlow teaches that the phases are of different colors and that one phase comprises the filling or core and the other phase comprises a peripheral border. Zietlow teaches that these confections are consumed with RTE cereals and are particularly marketable to children. Refer specifically to Column 1 line 20 through Column 3 line 31.

Regarding an appropriate size for the confection as about 0.1-10 grams and preferably 0.1-0.2 grams as recited in claims 10 and 11, since Roy teaches of cutting marbits to an appropriate size, but does not teach of specific size, one of ordinary skill in the art would have been motivated to look to the marbit art, such as Zietlow, for an art known marbit size. Thus, one of ordinary skill in the art at the time the invention was

made would have been motivated to cut the marbits as taught by Roy to a size weighing 0.16-0.25 grams a piece as taught by Zietlow. One would have been further motivated to cut the marbits of Roy to a size of 0.16-0.25 grams in order for the confection to be an appropriate size to be included in an RTE cereal as taught by Zietlow. To cut a confectionary material to a known and art appropriate size would have been obvious and routine determination to one of ordinary skill in the art at the time the invention was made.

Regarding the marbit as consumed with an RTE cereal, as a portion of a composite food product, having a first marbit portion as filling or core and a second phase of a second color as a peripheral border, as recited in claims 19, 20, 22, 24, 27, 29-31, and 36, Roy teaches of making marbits, but does not teach of how they are intended to be consumed, thus one of ordinary skill in the art would have been motivated to look to the marbit art, such as Zietlow, for a known method of consumption. One of ordinary skill in the art at the time the invention was made would have been motivated to package to marbit with an RTE cereal, as a composite food product, having a first marbit portion as filling or core and a second portion of a second color as a peripheral border in order to appeal to children as taught by Zietlow. One would have been further motivated for the marbit phases, i.e. the peripheral border and the core or filling, to be determined based upon the coloring and/or flavors of the phases and the desired perceived effect when first consuming the product; i.e. if an orange flavoring and coloring was desired for the consumer to experience first and then a grape flavor and coloring as a core, it would have been obvious for the phase with the orange color and flavoring to be the peripheral border and for the phase with the grape color and flavoring to be the core phase. To adjust the phases and serving method of a marbit by well known methods in the art, such as taught by Zietlow, and would be obvious and routine determination.

Claims 16-18, 20, 21, 23, 25, 26, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933) in view of Zietlow (US 6207216 B1).

Roy teaches of aerated confections with additional textures, tastes, flavors, and an enhanced nutritional composition, including marbits as discussed above. Roy is silent to the marbit as including a nutritionally fortifying ingredient, including a mineral as recited in claim 16, a therapeutic or ethical drug as recited in claim 17, about 0.1-5% of a calcium concentration as recited in claim 18, and at least one vitamin as recited in claim 23, to the aerated confection as a phase or portion of a composition food product as recited in claim 20, including in the form of a topical coating as recited in claim 21, to the marbit as in the form of a wafer having a thickness of about 1-5mm as recited in claims 25 and 26, and to the marbit as including 0.05-1% of a high intensity sweetener as recited in claim 33.

Zietlow teaches that marbits are enhanced with about 0.01-25%, preferably 1-10% supplemental materials, including high potency sweeteners and nutritionally fortifying ingredients (Column 4 lines 43-51). Zietlow teaches that in preferred embodiments the marbit is fortified with about 0.15-10% calcium (Column 4 lines 52-67). Zietlow teaches that confections are appealing carriers for ethical drugs, vitamins and minerals (Column 7 lines 58-61). Zietlow teaches that the marbits are in many forms, including as a wafer with a thickness of about 1 to 5 mm, and as part of a composite food product including bars, with cereals, as topical coatings, etc (Column 5 lines 36-47 and Column 7 lines 38-57).

Regarding the marbit as taught by Roy as including a nutritionally fortifying ingredient, including a mineral as recited in claim 16, a therapeutic or ethical drug as recited in claim 17, about 0.1-5% of a calcium concentration as recited in claim 18, and at least one vitamin as recited in claim 23, Zietlow teaches that aerated confections or marbits can be nutritionally enhanced and are good carriers for vitamins, minerals including 0.15-10% calcium, and ethical drugs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include nutritionally fortifying ingredients within the marbit composition of Roy in order to enhance the nutrition of the final product and provide a product which was a good drug carrier as taught by Zietlow. One would have been motivated to add a particular known marbit enhancer depending on the known function of the enhancer and the properties desired

in the final product. For example, one would have been motivated to include about 0.1-10% calcium, i.e. a mineral in the preferred amount for confections, in the marbit of Roy in view of Zietlow, when a final product with the known benefits of calcium, including a final product which would promote stronger bones and teeth, was desired; one would have been motivated to include vitamin C, in the marbit of Roy in view of Zietlow, when a final product with the known benefits of vitamin C, including a final product which would promote a stronger immune system and fight sickness, was desired; and one would have been motivated to include a therapeutic or ethical, such as ibuprofen in the marbit of Roy in view of Zietlow, when a final product with the known benefits of ibuprofen, such as pain reduction was desired. To include known ingredients for their known function in confectionary products would be obvious and routine determination of one of ordinary skill in the art.

Regarding the marbit as including 0.05-1% of a high intensity sweetener as recited in claim 33, Zietlow teaches that the addition of 1-10% of a high intensity sweetener enhances the properties of marbits. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include 1-10% of a high intensity sweetener within the marbit composition of Roy in order to enhance the final product as taught by Zietlow. One would have been motivated to include 1-10% of a high intensity sweetener in the marbit composition as taught by Roy in view of Zietlow in order to enhance the sweetness of the final product. To include known ingredients for their known function in confectionary products would be obvious and routine determination of one of ordinary skill in the art.

Regarding the marbit as consumed as part of a composite food product in the form of a topical coating as recited in claims 20 and 21, and as in the form of a wafer with a thickness of about 1-5mm as recited in claims 25 and 26, Roy teaches of making marbits, but does not teach of how they are intended to be consumed, thus one of ordinary skill in the art would have been motivated to look to the marbit art, such as Zietlow, for a known method of consumption. One of ordinary skill in the art at the time the invention was made would have been motivated to use the marbit for a known method of consumption depending on the final product desired. For example, one of

ordinary skill in the art at the time the invention was made would have been motivated to package the aerated confection as taught by Roy as a topical coating on a bar in order to enjoy the confection with products such as granola and peanut butter; and one of ordinary skill in the art at the time the invention was made would have been motivated to package the aerated confection as taught by Roy as a wafer with a thickness of about 1 to 5 mm in order to easily consume the confection alone (i.e. without other confectionary supports). To modify the form of the marbit as taught by Roy by known methods as taught by Zietlow would be obvious and routine determination of one of ordinary skill in the art.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933), in view of Zietlow (US 6207216 B1), further in view of Igoe (Dictionary of Food Ingredients, 4th Edition page 138).

Roy teaches of aerated confections, including marbits as discussed above. Roy is silent to the aerated confection as including a high intensity sweetener including sucralose as recited in claim 34. Zietlow teaches that the marbits can include 1-10% high potency sweeteners to further enhance the organoleptic properties of the marbit (Column 4 lines 46-51). As stated above, one of ordinary skill in the art at the time the invention was made would have been motivated to include 1-10% of a high potency sweetener in the aerated confection as taught by Roy in order to enhance the organoleptic properties of the aerated confection taught by Zietlow. Zietlow is silent to the type of high potency sweetener, including sucralose, to use in the aerated confection as recited in claim 34.

Igoe teaches that sucralose is a high intensity sweetener which is commonly used in confectionary products. Igoe teaches that the sucralose has 0 calories and is 600 times as sweet as sugar with a similar flavor profile. Igoe teaches that it is heat stable, readily soluble, and maintains its stability at elevated temperatures. Refer specifically to page 138. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include sucralose in the aerated confection as

disclosed by Roy in view of Zietlow and Igoe. One would have been motivated to include sucralose as the high intensity sweetener in the confection as taught by Roy in view of Zietlow for the known benefits of sucralose, including that it provided a lower-calorie sugar free product, it was 600 times as sweet as sugar with a similar flavor profile, heat stable, readily soluble, and maintained stability at elevated temperatures, as taught by Igoe.

Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933), in view of Zietlow (US 6207216 B1) and Igoe (Dictionary of Food Ingredients, 4th Edition), further in view of Gajewski (US 4251561).

Roy teaches of aerated confections including marbits comprising gelatin as discussed above. Roy teaches that the marbits include gelatin with a bloom strength of 225. As discussed above, Roy in view of Zietlow teach the confection as a portion or top coating on a bar as recited in claim 39. The references do not teach the gelatin with a bloom strength of at least 250 as recited in claim 37.

Gajewski teaches an aerated confection comprising gelatin (Abstract). Gajewski teaches that the bloom strength of the gelatin used should be between 150 and 300 with the best results being obtained between 250 and 300 (which would include the instantly claimed bloom of 250). Gajewski teaches that less gelatin is required when gelatins having high bloom strengths are employed. Refer specifically to Columns 4, lines 49-68 and Column 5, lines 1-18.

Regarding the gelatin as having a bloom strength of 250 as recited in claim 37, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used gelatin with a bloom strength of 250 to 300 in the aerated confection as taught by Roy in view of Gajewski. One would have been motivated to do so because a bloom strength of 250-300 is preferred in aerated confections and in order to save materials and thus money as by using a high bloom strength, less gelatin would be required for the substantially the same results as taught by Gajewski.

(10) Response to Argument

Appellant's arguments and declarations in the brief of June 29, 2009 have been fully considered but they are not persuasive.

Appellant's arguments and affidavit state that it has been established that there was a reduction to practice of the present invention prior to the prior art date of October 31, 2003 in Roy et al, thus removing Roy et al. as prior art. Appellant's affidavit and arguments are not convincing as the affidavits rely on the submitted evidence (brief, additional evidence) to show reduction to practice and the evidence does not establish possession of the whole invention as claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it (MPEP 715.02).

The evidence provided can be broken down into four parts; part one: pages 1-2, which includes the page titled Product Developer's Batches 33-44 and the page entitled Batch Sheet 33-44; part two: page 3 which includes the page entitled plan; part 3: page 4 which is a Sample table; and part 4: pages 5-8 which includes a General Mills, Inc. Intra-Company Correspondence. Part 1 is specified to experiments or samples titled "Batches 33-44"; part 2 appears to specify batch slurries 37, 33, and 41, however it is unclear as to if batch 33 is related to the batch 33-44 of part 1; part 3 specifies batches 33-60, 34-60, 35-60, 36-60, 37-60, 38-60, 39-60, 40-60, 41-60, 42-60, 43-60, and 44-60 which do not appear to be related to the batches of either part 1 or part 2; and part 4 does not recite any batch numbers and thus it is unclear as to if the information related to the batches of parts 1-3. Thus the parts taken individually as they appear to be unrelated. The evidence, including all four parts, does not establish possession of the whole invention as claimed or something falling within the claim, in the sense that the claim as a whole reads on it:

Part 1 shows a confectionary composition with 77% of a saccharide, 1.9% gelatin, fat and glycerin. Part 1 does not establish position of the instantly claimed invention as a whole because part 1 shows 77% by dry weight of a saccharide solution and 6.05% gelatin; part 1 does not show 1-10% moisture, a density of 0.1-0.35g/cc, a water activity of 0.1-0.4, and about 5-25% of a

softening agent as instantly claimed. Additionally, fat appears to be an essential part of the composition in part 1 and fat is not required in the instant invention, further distinguishing the evidence from the instant invention in that the composition of the evidence and the composition as instantly claimed do not parallel one another.

Part 2 does not establish position of the instantly claimed invention as a whole because part 2 shows fat in combination with 6.7-15% ml/gram bas glycerin; part 2 does not show about 65-98% of a saccharide component, about 0.05-15% of a foaming agent, about 0.5-20% of a structuring agent, 1-10% moisture, a density of 0.1-0.35g/cc, the dry weight basis of the softening agent as about 5-25%, and a water activity of 0.1-0.4 as instantly claimed. Additionally, fat appears to be an essential part of the composition in part 2 and fat is not required in the instant invention, further distinguishing the evidence from the instant invention in that the composition of the evidence and the composition as instantly claimed do not parallel one another.

Part 3 does not establish position of the instantly claimed invention as a whole because part 3 shows a moisture content of about 1-13% and a water activity of 0.101-0.171; part 3 does not show about 65-98% of a saccharide component, about 0.05-15% of a foaming agent, about 0.5-20% of a structuring agent, about 5-25% of a softening agent and a density of 0.1-0.35g/cc as instantly claimed.

Part 4 does not establish position of the instantly claimed invention as a whole because part 4 shows a composition with 20% saccharide (10% sorbitol and 10% propylene glycol), 30% fat, and up to 10% glycerol; part 4 does not show about 65-98% of a saccharide component, about 0.05-15% of a foaming agent, about 0.5-20% of a structuring agent, 1-10% moisture content, a water activity of 0.1-0.4, and a density of 0.1-0.35g/cc as instantly claimed. Additionally, 30% fat appears to be an essential part of the composition in part 4 and fat is not required in the instant invention, further distinguishing the evidence from the instant invention in that the composition of the evidence and the

composition as instantly claimed do not parallel one another. It is noted that claim 9 of the instant invention requires less than 5% fat, which includes 0% fat and is not near or about 30% fat.

Possession of the invention as a whole has not been established as the evidence provided by appellant is inconsistent, inconclusive, and does not parallel the instant invention. There is no evidence provided to support that the instantly claimed invention was in fact conceived and reduced to practice prior to the prior art date of October 31, 2003. Thus, as stated above, appellant's affidavit and arguments concerning the affidavit are not convincing as there is no evidence to show conception and reduction to practice of the instantly claimed invention prior to the prior art date of Roy.

Appellant further argues that density and springback factor as instantly claimed but not shown as evidence in the affidavit are simply ways to quantify the qualities discussed in the inventor's journal which mean the same thing, i.e. soft and chewy at low moisture levels. Appellant's argument is not convincing as 1) it is unclear where the qualities "soft and chewy at low moisture levels" were discussed in the evidence and 2) just because a confection is soft and chewy does not mean that the confection will have the density and spring back factors as instantly claimed; the characteristics do not necessarily correspond to the instantly claimed values.

Appellant argues that the references of record, specifically Roy does not teach of a marbit with the same glass transition temperature and spring back factor as instantly claimed. Appellant's argument is not convincing, as stated above, as claim 1 recites, "about 5-25% of a softening agent to provide a glass transition temperature... and a spring back factor..." and the claims recite that the softening agent is glycerin (instant claims 8 and 12), since Roy teaches of an aerated confection with substantially the same confectionary composition as instantly claimed, including the instantly claimed softening agent within the instantly claimed range, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same properties provided from the softening agent, including glass transition temperature and spring back factor, as instantly claimed, absent any clear and convincing arguments and/or

evidence to the contrary. At the present time, appellant has provided no such arguments or evidence beyond the simple statement that the products are just different.

Appellant argues that the references of record, specifically Roy does not teach of a marbit with the same softness as instantly claimed. Appellant's argument is not convincing, as stated above, as softness is a function of moisture content and softening ingredients and since Roy teaches of an aerated confection with substantially the same composition as instantly claimed, including the instantly claimed softening agent within the instantly claimed range and the instantly claimed moisture content, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same "softness" as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary. At the present time, appellant has provided no such arguments or evidence beyond the statement that the products have a different softness because Roy teaches a product which includes sodium hexametaphosphate and fruit solids. This argument is not convincing as (1) the references of record teach of a product which comprises substantially the same composition as the instantly claimed product; (2) the claims recite a composition "comprising" specific ingredients and thus while the ingredients listed must be included in the composition, the claims do not exclude additional ingredients; (3) the prior art discloses minor amounts of additional ingredients, including about 0.5-20% fruit and 0.01-0.2% hexametaphosphate; and (4) Appellant's specification, paragraphs 0022, 0042 and 0054 teach that both fruit and hexametaphosphate can be included in the instantly claimed invention.

Appellant argues that the references of record, specifically Roy does not teach a final density of about 0.1-0.35g/cc as instantly claimed because the density as taught by Roy, 0.17-0.48g/cc is at the point of aeration which is before extrusion and drying (Roy paragraphs 0007 and 0016) and extrusion and drying would modify the density of the final product. Appellant's argument is not convincing as appellants specification, paragraphs 0078-0084, also states that the density during aeration before extruding and drying is at about 0.1-0.5 g/cc, preferably about 0.15 to 0.35g/cc. Thus appellant's argument is not convincing as 1) the reference of record teach the confection with the substantially the same density at substantially the same processing step and 2) based

upon appellant's statements in the specification, it appears that the basis of appellants argument that extruding and drying have a significant affect upon the final density is incorrect.

Appellant argues that the references of record, specifically Roy does not teach of a marbit with the same compressibility and bulk compressibility factor as instantly claimed. Appellant's argument is not convincing, as stated above, as compressibility and bulk compressibility is based on product composition and the degree of aeration provided to the product and since Roy teaches of an aerated confection with substantially the same composition as instantly claimed and with substantially the same density and thus degree of aeration, one of ordinary skill in the art would expect that the product of Roy inherently have substantially the same compressibility and bulk compressibility as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary. At the present time, appellant has provided no such arguments or evidence beyond the statement that the products have a different softness because Roy teaches a product which includes sodium hexametaphosphate and fruit solids. This argument is not convincing as (1) the references of record teach of a product which comprises substantially the same composition as the instantly claimed product; (2) the claims recite a composition "comprising" specific ingredients and thus while the ingredients listed must be included in the composition, the claims do not exclude additional ingredients; (3) the prior art discloses minor amounts of additional ingredients, including about 0.5-20% fruit and 0.01-0.2% hexametaphosphate; and (4) Appellant's specification, paragraphs 0022, 0042 and 0054 teach that both fruit and hexametaphosphate can be included in the instantly claimed invention.

Further regarding the inherent features of the reference, appellant is reminded that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not." In re Spada, 911F.2d

705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, it is noted that appellant has chosen to use an equation with parameters that cannot be measured by the Office, for the purpose of prior art comparison, because the office is not equipped to manufacture prior art products and compare them for patentability. Therefore, the burden is shifted to the appellant to show that the prior art product is different.

In response to appellant's argument that Zietlow teaches away from the invention by teaching a crisp marshmallow, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The composition of Roy is substantially the same as the instantly claimed invention and the reference of Zietlow is relied upon for optional marbit ingredients and methods in which marshmallows can be consumed. Appellant's argument is not convincing as the entire reference of Zietlow need not be bodily incorporated into the teachings of Roy.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kelly Bekker/

Kelly Bekker

Conferees:

/Keith D. Hendricks/

Supervisory Patent Examiner, Art Unit 1794

/Jennifer Michener/

QAS, TC1700